

STATEMENT OF CONSIDERATIONS


ADVANCED WAIVER OF DOMESTIC AND FOREIGN PATENT RIGHTS
TO UNITED TECHNOLOGIES UNDER COOPERATIVE AGREEMENT NO.
DE-FC02-00CH11060; W(A)-02-013; CH-1097

As brought out in the attached Statement of Considerations granting an advanced waiver of domestic and foreign patent rights to United Technologies Corporation (hereinafter "United Technologies") under Cooperative Agreement No. DE-FC02-00CH11060, Waiver No. W(A)-00-037, United Technologies is leading a teaming arrangement to demonstrate technologies that will substantially increase the performance and reduce the cost and emissions of microturbines for electric utility power systems. The teaming arrangement will include a variety of subcontractors including subsidiaries and controlled affiliates of United Technologies as well as other independent entities unrelated to United Technologies' organization.

The total projected cost of the work under this agreement is \$13,661,870, of which United Technologies is obligated to provide \$5,040,477 or approximately a 37 percent of the total cost of the agreement. In view of the cost sharing and other equities among the parties to this agreement, it is anticipated that the team will develop an appropriate allocation of patent rights among the participants to facilitate the expeditious development of the technology forming the subject matter of the agreement. The purpose of this waiver is to expand upon the scope of the foregoing waiver to enable the parties to meet this objective.

Accordingly, DOE will waive title to all subject inventions made by United Technologies' employees and its subcontractors' employees, except inventions made by subcontractors eligible to retain title pursuant to P.L. 96-517, as amended, or National Laboratories, to United Technologies or its subcontractors, as mutually agreed by the parties. Except as otherwise specifically approved by DOE Patent Counsel, a party's acceptance of a subcontract under this agreement shall constitute that party's notice to DOE that it accepts the terms and conditions of this advance waiver. Subject to the foregoing, the terms and conditions of this waiver are the same as in Waiver No. W(A)-00-037 noted above.

Considering the foregoing, it is believed that granting this waiver will provide Petitioner with the necessary incentive to invest its resources in the commercialization of the results of the cooperative agreement in a fashion which will make the above technology available to the public in the shortest practicable time. Therefore, upon evaluation of the original waiver petition and in view of the objectives and considerations set forth in 10 CFR Part 784, all of which have been considered, it is recommended that the requested waiver be granted.


Thomas G. Anderson
Assistant Chief Counsel
Intellectual Property Law Division

Date: 3/21/02

Based upon the foregoing Statement of Considerations and representations in the attached waiver petition, it is determined that the interests of the United States and the general public will best be served by a waiver of patent rights of the scope described above, and therefore the waiver is granted. This waiver will not apply to any modification or extension of the contract, where through such modification or extension, the purpose, scope or cost of the contract has been substantially altered.

CONCURRENCE:


Robert K. Dixon
Deputy Assistant Secretary
Office of Power Technologies
EE-10/FORS

Date: 4/4/02

APPROVAL:


Paul A. Gottlieb
Assistant General Counsel for Technology
Transfer and Intellectual Property, GC-62

Date: 4-8-02